

# Notice of Allowability

## Application No.

10/088,676

## Applicant(s)

DUCKER ET AL.

## Examiner

Manjunath N. Rao, Ph.D.

## Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--  
claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included  
reewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS  
NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative  
the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

☒ This communication is responsive to the amendment filed on 8-20-04.

☒ The allowed claim(s) is/are 1-7,9 and 11-19.

☒ The drawings filed on 21 March 2002 are accepted by the Examiner.

☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some\* c) ☒ None of the:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the  
International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements  
noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF  
INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.

☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.

(a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached

1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.

(b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of  
Paper No./Mail Date \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of  
each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the  
attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

☒ Notice of References Cited (PTO-892)

☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_

☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material

5. ☐ Notice of Informal Patent Application (PTO-152)

6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_.

7. ☒ Examiner's Amendment/Comment

8. ☒ Examiner's Statement of Reasons for Allowance

9. ☐ Other \_\_\_\_\_.

Manjunath N. Rao, Ph.D.  
Primary Examiner  
Art Unit: 1652

Art Unit: 1652

### **DETAILED ACTION**

Claims 1-7, 9, 11-20 are currently pending and are present for examination.

Applicants' amendments and arguments filed on 8-20-04, have been fully considered and are deemed to be persuasive to overcome the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. Specifically Examiner has withdrawn the previous rejection under 35 U.S.C. 112, 1<sup>st</sup> and 2<sup>nd</sup> paragraph in view of claim amendments. Rejection of claims under 35 U.S.C. 102 has been withdrawn in view of claim amendments and persuasive arguments provided by the applicant. Amendment to specification which overcome the previous objection is also acknowledged and entered.

### ***Drawings***

Drawings submitted in this application are accepted by the Examiner for examination purposes only.

### **EXAMINER'S AMENDMENT**

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Richard Lebovitz on 10-28-04.

The application has been amended as follows:

Art Unit: 1652

- A) In claim 1, lines 7-8, insert the following phrase “wherein said polypeptide has heparanase activity” after “SEQ ID NO:2”.
- B) In claim 4, line 26, insert the following phrase “wherein said polynucleotide encodes a polypeptide having heparanase activity” after “(a)-(f)”.
- C) In claim 9, line 2, insert the phrase “wherein said fusion protein continues to have heparanase activity”, after “claim 1”.
- D) Please cancel claims 10, 12 and 13 without any prejudice.
- E) In claim 14, line 1, delete “(b) or (c)” after “claim 1,”.

***Allowable Subject Matter***

Claims 1-7, 9, 11, 14-20 are allowed.

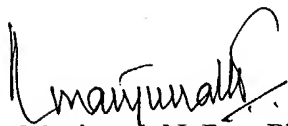
The following is an examiner’s statement of reasons for allowance: Following a diligent search it was determined that the prior art neither teaches nor suggests a polynucleotide with SEQ ID NO:1 encoding a polypeptide with SEQ ID NO:2 having heparanase activity as claimed in claims 1-7, 9, 11, 14-20.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled “Comments on Statement of Reasons for Allowance.”

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 571-272-

Art Unit: 1652

0939. The Examiner can normally be reached on 7.00 a.m. to 3.30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306/9307 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.



Manjunath N. Rao, Ph.D.  
Primary Examiner  
Art Unit 1652

October 28, 2004